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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/628,142

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Ignatius Xavier Haase

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09/09/2008

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EXAMINER

BLACKWELL, JAMES H

ART UNIT

PAPER NUMBER

2176

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/628,142	<b>Applicant(s)</b> HAASE, IGNATIUS XAVIER	
	<b>Examiner</b> James H. Blackwell	<b>Art Unit</b> 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,5,7,8,13 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,7,8,13 and 17-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/14/2007 has been entered.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 5, 7-8, 13 and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Rivette et al. (hereinafter Rivette, U.S. Patent No. 5,623,679 filed 04/18/1995, issued 04/22/1997).

**In regard to independent Claim 1, Rivette discloses:**

- *A method of encoding a document* (at least Title; Col. 4, lines 17-19 → ...  
creating an manipulating notes each containing multiple sub-notes, and linking

the sub-notes to portions of data objects that are highlighted by the user),  
*comprising the steps of:*

- *identifying multiple characteristics about text of the document* (Fig. 37; Col. 36, line 40 through Col. 37, line 21 → a user can choose to annotate portions of a document (words, sentences, paragraphs, etc.) by highlighting those portions using a marker of a desired color by, for example, “clicking” and “dragging” a mouse to highlight the portion. The highlighting also creates a “color indicator” (542) in the margin with the same color as that of the highlight). The user, in highlighting text in this manner is interpreted to have *identified a characteristic about text of the document*, as claimed. In addition, the “color indicator” is further identified with a shape (square, triangle, and circle). Further, it is possible to overlap highlights made on the same portion of text (Col. 37, lines 13-21) creating multiple “color indicators” in the margin adjacent to the highlighted text. Thus, the user can *identify multiple characteristics about text of the document* in this way.
- *creating a key for correlating the multiple characteristics with multiple unique indicia* (Figs. 11, 56, 62; Col. 41, lines 1-26 → selection of a patent note icon downward arrow (127, Fig. 11) results in the display of a menu (902) in Fig. 62 listing all patent notes which have been sorted according to the specifications in the preferences dialog box 770 in Fig. 56. As shown, the patent notes include various symbol icons in appropriate colors

as well as a numerical indicator of the patent note number.) This pull-down menu is interpreted a *key* or legend to the “color indicators” in the margins. As the user highlights more text, more entries are added to this pull-down menu. Thus, the key or legend is “created” and added to in the process of adding new highlights (and subsequently more notes).

- *placing at least some of the unique indicia adjacent at least some lines of text in the document* (see Fig. 37, items 540, 542 → highlight and corresponding “color indicator” in margin adjacent to the highlighted text),  
*wherein*
  - *the unique indicia placed adjacent each line of text correspond to the characteristic or characteristics in the line of text on the basis of the key* (see Fig. 37, items 540, 542; Col. 37, lines 13-21 → highlight and corresponding “color indicator” in margin adjacent to the highlighted text, and multiple, overlapping highlights and “color indicators” created),

*wherein*

- *there is at least one line of text having at least two unique indicia adjacent thereto* (Col. 37, lines 13-21 → creating multiple “color indicators” in the margin adjacent to the highlighted text),

*wherein*

- *in the steps of creating and placing the unique indicia comprise color-coded segments* (Col. 36, line 40 through Col. 37, line 21 →

highlighting text produces a corresponding shaped, colored coded (Col. 36, lines 61-63) “color indicator” in the margin adjacent to the text that was highlighted). A segment is interpreted as a single item such as a single “color indicator”), *and*

- *the color-encoded segments are placed in a margin adjacent to and in line with the text of the line (Figs. 37, 63, window labeled 160; → “color indicators” are seen in a margin adjacent to and in line with the text of the line), and*

*wherein*

- *there are at least some color-coded segments placed contiguously with the same color-coded segments from adjacent lines of text and in a columnar arrangement perpendicular to the lines of text, so as to form contiguous segments of color-coding (at least Fig. 63, window labeled 160 → displays two triangles of the same color (actually lack of color in the Figure) placed “contiguously” and in a columnar arrangement perpendicular to the lines of text), and*
- *at least some lines of text have at least two characteristics and a corresponding number of unique indicia in the margin adjacent the lines (at least Col. 37, lines 13-21; Figs. 37, 63 → multiple characteristics can be indicated for a line with a corresponding number of color indicators in a horizontal row adjacent to one another).*

**In regard to dependent Claim 3, Rivette discloses:**

- *the document is stored on a digital medium* (Col. 3, lines 52-54; Col. 4, lines 17-19; Col. 15 line 65 through Col. 16, line 1 → equivalent files and image files reside on a hard disk drive or CD disk. Patent notes and sub-notes are stored in a database (Col. 42, line 35)), *and*
- *in the steps of creating and placing,*
  - *the key is stored on a digital medium* (Fig. 61, item 127; Col. 42, lines 39-63 → pull-down menu shows notes with corresponding indicia (shape icons and colors) that have been created so far. This feature represents a key which allows the user (by shape, color, and number) to distinguish between notes made). As the user adds highlighting and notes, the GUI keeps track (and likely stores) this information.
  - *the unique indicia are stored in a digital medium* (Col. 42, line 35, 39-63 → indicia are stored with notes/sub-notes which are stored in a database).

**In regard to dependent Claim 5, Rivette discloses:**

- *selectively changing the key by changing at least one of the color-coding and the characteristics* (Fig. 61, item 127; Col. 42, lines 39-63 → pull-down menu shows notes with corresponding indicia (“color indicators”) that have been created so far. This feature represents a key which allows the user (by shape, color, and number) to distinguish between notes made). It is clear that if the user adds, removes, or makes other changes to the notes, that the pull-down menu (key)

would be altered to reflect the current state of the number, and type (color, shape) of notes present in the content).

**In regard to Claim 7**, Claim 7 merely recites a system for performing the method of Claim 1. Thus, Rivette discloses every limitation of Claim 7, as indicated in the above rejection for Claim 1.

**In regard to dependent Claim 8**, Rivette discloses:

- *the memory comprises a digital recording medium* ( see Fig. 1, items 25, 28);
- *processor* (see Fig. 1, items 8, 13, 20, 27);
- *selectively changing the key by changing at least one of the color-coding and the characteristics* (Fig. 61, item 127; Col. 42, lines 39-63 → pull-down menu shows notes with corresponding indicia (“color indicators”) that have been created so far. This feature represents a key which allows the user (by shape, color, and number) to distinguish between notes made). It is clear that if the user adds, removes, or makes other changes to the notes, that the pull-down menu (key) would be altered to reflect the current state of the number, and type (color, shape) of notes present in the content).

**In regard to Claim 13**, Claim 13 merely recites an encoded document depicting the method of Claim 1. Thus, Rivette discloses every limitation of Claim 13, as indicated in the above rejection for Claim 1.

**In regard to dependent Claim 17, Rivette discloses:**

- *the characteristics of each line are stored in a digital recording medium (Col. 3, lines 52-54; Col. 4, lines 17-19; Col. 15 line 65 through Col. 16, line 1; Rivette claims 1, 2 → equivalent files and image files reside on a hard disk drive or CD disk. Patent notes and sub-notes are stored in a database (Col. 42, line 35)).*
- *there is a step of selectively placing a plurality of the unique indicia corresponding to the multiple characteristics, based on the key, adjacent at least some of the lines of text (Fig. 37, items 540, 542 → upon highlighting text (540), a “color indicator” (542) is created in the margin of the document. Col. 36, lines 13-21 provide for multiple “color indicators” being placed adjacent to the line of text and to one another).*

**In regard to dependent Claim 18, Rivette discloses:**

- *a controller for enabling a user to select a plurality of the multiple characteristics, and for changing the display based on the selection to show the unique indicia, which correspond to the selected multiple characteristics (Col. 41, lines 1-26; Figs. 60-63 → a graphical user interface that allows the user to create, manipulate, delete and otherwise alter notes and sub notes).*

**In regard to dependent Claim 19, Rivette discloses:**

- *the document is stored on a digital medium (Col. 3, lines 52-54; Col. 4, lines 17-19; Col. 15 line 65 through Col. 16, line 1; Rivette claims 1, 2 → equivalent files*

and image files reside on a hard disk drive or CD disk. Patent notes and sub-notes are stored in a database (Col. 42, line 35)).

**In regard to dependent Claim 20, Rivette discloses:**

- *storing the document on the digital recording medium* (see Rivette claims 1, 2 → means for storing patent document components and notes (and hence “color indicators” on media)).

### ***Response to Arguments***

Applicant makes no arguments except to state that they believe amendments made to the claims now overcome the prior rejection of Rivette and in particular, the clarify that the marginal “highlighting” in the claimed invention is continuous between at least some adjacent lines of text, as discussed in a previous interview between the Applicant, the Applicant’s representative and the Examiner held July 31, 2007.

It is noted in the Interview Summary mailed 08/02/2007 that no agreement with respect to the claims was reached.

The Examiner respectfully disagrees with the Applicant’s assertion that their amendments overcome Rivette.

First, amendments to Claim 1 substantially comprise the incorporation of claim language from dependent claims 2, 4 and 6 which were previously rejected under 35 U.S.C. 102(b) as anticipated by Rivette. Claims 7 and 13 have also incorporated similar language from their corresponding dependent claims.

Second, new language was also added to the independent claims (i.e. “... *so as to form continuous segments of color-coding*”) apparently to further qualify the meaning of the term “contiguous” in describing same-colored segments (e.g. two green triangles) occurring in a column formed by adjacent lines as “butting up against one another” to form a “continuous” segment of color-coding.

The Examiner respectfully disagrees with the Applicant’s assertion that this additional language overcomes Rivette.

Rivette allows a user to highlight portions of text in order to generate a note about that text. The note and highlighting are designated by a color indicator (e.g. green triangle) corresponding to the color of the highlight chosen as defined in a legend or key.

Thus, Rivette would allow a user to highlight a first line of text (or portion thereof) thereby generating a color indicator (e.g. green triangle). The user could then move to the next line, and using the same highlighting color, highlight text in the next line and generate a second color indicator which would be the same as the first indicator (e.g., a second green triangle).

The user could conceivably do this for each adjacent line. What would result, according to Figure 63 of Rivette is a column of contiguous green triangles that, depending on perhaps the shape of the symbol (squares or rectangles might work better), line spacing (gap between two adjacent lines), symbol size (i.e. symbols larger than the height of a line of text), etc. would form a continuous segment of color-coding.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Blackwell whose telephone number is (571)272-4089. The examiner can normally be reached on 8-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on 571-272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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08/26/2008

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